

REMARKS

I. Status of Application

Claims 1-16 and 18 are all the claims pending in the application. Claims 1-16 and 18 presently stand rejected.

II. Formalities

Despite Applicant's request in the Amendment filed on October 16, 2008, the Examiner still has not returned the initialed Form PTO/SB/08 included with the IDS filed April 4, 2005 (although the Examiner has indicated that the references cited therein have been considered). Applicant again respectfully requests that the properly initialed Form PTO/SB/08 included with the IDS filed April 4, 2005.

III. Claim Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 1-3, 5, 8, 11, 12, 15 and 18 under 35 U.S.C. §103(a) as allegedly being unpatentable over JP 2000-043243 to Odai, in view of U.S. Patent No. 6,724,999 to Kikuchi and further in view of U.S. Patent No. 2,930,696 to Otsuki. Claim 4 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Odai, in view of Kikuchi, in view of Otsuki, and further in view of JP 10-081008A to Kakumori. Applicant respectfully traverses all of these rejections for *at least* the reasons set forth below.

A. Independent Claim 1

Independent claim 1 recites (among other things):

...wherein the conductive portion is formed by stripping off a part of the coating on the sheet feed roller or the idle roller.

The grounds of rejection acknowledge that Odai and Kikuchi fail to teach or suggest the above features. Nevertheless, the grounds of rejection rely on FIG. 8, element 25b of Otsuki as allegedly teaching the claimed conductive portion. Applicant respectfully disagrees with the grounds of rejection.

First, the upstream paper feed roller 25b of Otsuki (US 6,930,696 B2) is formed by attaching two small rollers to a shaft (*see col.12, lines 26-33; FIG,8*). Therefore, contrary to the grounds of rejection, Otsuki is completely silent regarding the feature of a conductive portion formed by stripping off a part of the coating on the sheet feed roller or the idle roller, as claimed.

Second, the grounds of rejection acknowledge that Odai fails to teach or suggest the claimed features of wherein the sheet feed roller or the idle roller is formed by coating a predetermined insulating coating on a surface of a conductive rod-shaped member. Nevertheless, the grounds of rejection rely on Kikuchi as allegedly teaching these features and allege that it would have been obvious to modify Odai with Kikuchi's roller, and to thereafter modify such a combination of Odai and Kikuchi with Otsuki so as to arrive at the claimed invention.

However, even assuming *arguendo* that Otsuki *were* to teach the claimed conductive portion formed by stripping off a part of the coating on the sheet feed roller or the idle roller, contrary to the grounds of rejection, such a conductive portion could not be applied to the teachings of Kikuchi. Quite to the contrary, Kikuchi discloses a pair of fixing rollers (i.e., a heating roller 2 and a pressing roller 3) in the fixing apparatus 1. If a roller having an irregular surface (like that shown according to an illustrative embodiment of the invention in FIG. 3 of the present application for example) were to be used as one of the fixing rollers of Kikuchi, then

such a roller would not work (i.e., it would impair its fixing function). Therefore, since modifying the teachings of Odai and Kikuchi with Otsuki, as proposed by the grounds of rejection, would render Kikuchi's fixing rollers unsatisfactory for its intended purpose, it would not have been obvious to modify the teachings of Odai with those of Kikuchi and Otsuki to arrive at the claimed invention for *at least* these reasons (*see* MPEP § 2143.01).

Third, the fixing rollers of Kikuchi must be disposed at a downstream side of a position where the ink droplets are ejected from the nozzles. Therefore, one of ordinary skill in the art would have recognized that the fixing rollers of Kikuchi cannot be used as the ground roller 12 of Odai, which is disposed at an upstream side of the recording head 11. Accordingly, it would not have been obvious to modify Odai with the fixing rollers of Kikuchi to arrive at the claimed invention for *at least* these reasons.

For *at least* the reasons discussed above, Applicant submits that claim 1 is patentable over Odai, Kikuchi, Otsuki, Kakumori, and any combination thereof. Further, the dependent claims 3-5, 8, 11 and 12 are patentable *at least* by virtue of their dependency. Accordingly, Applicant respectfully requests that the Examiner withdraw these rejections.

B. Independent Claim 15

In view of the similarity between the recitations of claim 15 and the recitations discussed above with respect to claim 1, Applicant submits that reasons analogous to those presented above regarding claim 1 demonstrate the patentability of claim 15. Further, the dependent claim 18 is patentable *at least* by virtue of its dependency on claim 15. As such, Applicant respectfully requests that the Examiner withdraw these rejections.

RESPONSE UNDER 37 C.F.R. § 1.111
Application No.: 10/530,174

Attorney Docket No.: Q87222

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/ Andrew J. Taska /

Andrew J. Taska
Registration No. 54,666

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

65565

CUSTOMER NUMBER

Date: March 24, 2009